REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, the specification (paragraphs beginning on pages 5 and 7) and claims (claims 1, 5, 7, and 9) have been amended to correct a typographical error in Formula (II) which arose during the translation of International Application No. PCT/FR00/02120, which was French, into the English language. Support for this correction to Formula (II) can be found in the above-identified International Application, the content of which was incorporated by reference in the present application. *See* Utility Patent Application Transmittal Letter at 2 (amending first page of the specification). Claim 9 has been further amended to recite "[a] method for treating disease and/or condition . . . , wherein said beta-naphthoquinone derivative is selected among the group . . . ." Claim 10 has also been amended to recite "said beta-naphthoquinone derivative . . . ." Support for these amendments to claims 9 and 10 can be found throughout the originally filed application. Accordingly, no new matter has been added.

Turning now to the Official Action, applicants note that the Examiner has withdrawn the election of species requirement. Thus, derivatives represented by both Formula (I) and Formula (II) have been examined in the present application.

Claims 9-11 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not provide adequate support for prevention of conditions

associated with the excessive release of glutamate by administering the compounds of Formula (I) or Formula (II). In making this rejection, the Examiner has explicitly stated that the specification is enabling for treatment of conditions associated with the excessive release of glutamate by administering naftazone or its glucuronide derivative. This rejection is respectfully traversed.

To expedite prosecution, and not to acquiesce to the Examiner's rejection, independent claim 9 has been amended to recite "[a] method for treating disease and/or condition . . . ."

In view of the above, the Examiner is respectfully requested to withdraw this enablement rejection.

Claim 10 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for purportedly failing to particulary point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner has stated that use of the phrase "said derivative" is confusing. This rejection is respectfully traversed.

The phrase "said derivative" in claim 10 is referring to the beta-napthoquinone derivative -- just as in the fifth line of claim 9 -- as opposed to the glucuronide derivatives having formula II. Therefore, to expedite prosecution, and not to acquiesce to the Examiner's rejection, claim 10 to recite "said beta-napthoquinone derivative." This amendment is not intended to the limit the scope of claim 10 or any element recited therein.

In view of the above, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

Further, claims 9-11 have been rejected under 35 U.S.C. § 102(a) as purportedly being anticipated by Mattei et al. (*Neuroscience Letters*, 271:183-86 (1999)). This rejection is respectfully traversed.

The article by Mattei et al. in *Neuroscience Letters* was published on August 27, 1999. *See* Exhibit A (copy of PubMed Abstract). The present application, however, claims benefit of priority under 35 U.S.C. §§ 119 and/or 365 to FR 99/09469 filed in France on July 21, 1999. It is noted that the Examiner has acknowledged receipt of the certified copies of this priority document. Since the article by Mattei et al. is "before" applicants priority date, the Mattei et al. article not proper prior art.

In view of the above, the Examiner is respectfully requested to with this rejection.

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions concerning this amendment or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 22, 2003

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EXHIBIT A

1: Neurosci Lett. 1999 Aug 27;271(3):183-6.

ELSEVIER FULL-TEXT ARTICLE

Related Articles, Links

Naftazone reduces glutamate cerebro spinal fluid levels in rats and glutamate release from mouse cerebellum synaptosomes.

Mattei C, Molgo J, Joseph X, Israel M, Bloy C.

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It is well known that an excessive release of glutamate in the mammalian brain plays a major role in several neurological diseases. Naftazone (Etioven) is a currently used vasoprotectant drug that is metabolized in humans by reduction and glucuronidation. In the present study naftazone was found to decrease glutamate levels in the cerebro spinal fluid (CSF) of rats treated for 15 days, as determined by a chemiluminescent glutamate assay reaction. Naftazone and its glucuronide derivative also reduced respectively spontaneous and high K+-evoked glutamate release from mouse cerebellum synaptosomes. It is likely that naftazone and its glucuronide metabolite contribute in vivo to decrease glutamate levels in the CSF through their inhibitory actions on glutamate release.

PMID: 10507699 [PubMed - indexed for MEDLINE]